

REMARKS/ARGUMENTS

Claims 1- 49 are in the application. No claims have been canceled. Claim 19 has been amended to correct a clerical error.

The specification at pages 15 and 19 has been amended to correct clerical errors.

Double Patenting Rejection

Claims 1-5, 7-13, 19-23, 25-31, 37-38, and 40-45 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 6,405,225 to Apfel et al.

Applicants are filing herewith a Terminal Disclaimer whereby the patent issuing from the present application will expire at the same time as U.S. Patent No. 6,405,225. Accordingly, the double patenting rejection should be withdrawn.

Claim Rejections – 35 U.S.C. § 112

Claim 19 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 has been amended to correct a clerical error. In claim 19, line 1, the beginning phrase “In or for” has been deleted. Accordingly, the phrase “A computer system” now provides a subject for the preamble of the claim. The objection under 35 U.S.C. § 112 should be withdrawn.

Claim Rejections – 35 U.S.C. § 102

Claims 1-2, 4-5, 12, 19-20, 22-23, and 30 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,529,942 to Gilbert.

The Gilbert patent is directed to embedding text format commands in an e-mail message input by the user. The purpose of the embedded commands is to customize e-mails provided to different addressees. Accordingly, when the Gilbert reference discusses embedding content into an e-mail message, it is embedding commands into a message that the user has already generated or is in the process of generating. The Gilbert reference does not receive a portion of a document

and code that portion for transmission as electronic mail; nor does the Gilbert reference do the coding in response to a send command.

With regard to the claims, claims 1 and 19 include operative elements for receiving a pre-selected portion of a document and in response to a send command, coding this pre-selected portion for transmission via electronic mail. As discussed above, the Gilbert reference does not teach receiving a pre-selected portion of a document nor does it teach coding that portion for transmission via e-mail. Accordingly, claims 1 and 19 differ from the Gilbert reference and should be allowed.

Claims 2, 4-5, and 12 are dependent from claim 1 and should be allowed for the same reasons as discussed above for claim 1. Likewise, claims 20, 22-23, and 30 are dependent from claim 19 and should also be allowed for the same reasons as discussed above for claim 19.

Claim Rejections – 35 U.S.C. § 103

Claims 6-8, 11, 13-14, 16-18, 24-26, 29, 31-32, 34-36, 37, 39-41, 44-45, and 47-49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,529,942 to Gilbert in view of U.S. Patent No. 6,157,934 to Khan et al.

The Khan et al. reference is cited by the examiner for teaching the coding of a spreadsheet document with cells for manipulation via e-mail. The examiner asserts that it would be obvious to add Khan's teachings to Gilbert's teachings.

The Khan reference is directed to a server/client system and distributed processing of a spreadsheet. Khan does not explain how he proposes to link the client and server other than to say by electronic mail or by the Internet. Presumably Khan is attaching his spreadsheet data files to e-mails but there is no clear indication of what Khan is doing. Khan does not fill the deficiencies of the Gilbert reference with regard to the differences between applicants' invention and the Gilbert reference as discussed above for claims 1 and 19. Claims 25, 26, 29, and 36 depend from claim 19. Since the Khan reference fills none of the deficiencies of the Gilbert reference, these claims are allowable for at least the same reasons as discussed above for claim 19. Claims 25, 26, 29, and 36 should be allowed.

Claims 7, 8, 11, 18, and 49 are rejected on the same basis as claims 25, 26, 29, and 36. Claims 7, 8, 11, and 18 depend from claim 1 and should be allowed for the same reasons as

discussed above for claim 1. Claim 49 will be discussed hereinafter after the discussion of claim 37 from which claim 49 depends.

Regarding claim 37, there are numerous operative elements not taught by either Gilbert or Khan. Exemplary of the elements not taught by Gilbert or Kahn are the elements of receiving a pre-selected portion of a document, and in response to a send command, coding the pre-selected portion for transmission via electronic mail, inserting the coded pre-selected portion into an e-mail message, detecting a command to apply interactive control to the pre-selected portion, and in response to receiving a command to apply interactive control, coding an interactive control for the pre-selected portion and inserting the coded interactive control into the e-mail message. Gilbert only teaches creating an original message and inserting text format commands into that e-mail message. Khan only teaches attaching data to an e-mail. The method of attachment is not described. The Gilbert reference and the Khan reference alone or combined do not teach coding a pre-selected portion of a document and also coding interactive controls so that when a recipient receives the e-mail he will have not only the selected portion but also interactive controls that he may apply to the pre-selected portion. Claim 37 because of these differences is clearly patentable over the Gilbert reference and the Khan reference and should be allowed.

Regarding claim 49, this claim depends from claim 37 and should be allowed for at least the same reasons as discussed above for claim 37.

The examiner asserts that claims 13, 14, 31, and 32 feature limitations similar to claim 37 and are rejected for the same reasons as claim 37. Claims 13 and 14 are dependent from claim 1, and claims 31 and 32 are dependent from claim 19. These claims should be allowed for the same reasons as discussed above for claims 1 and 19. In addition, claims 13, 14, 31 and 32 should be allowed in their own right as Khan does not teach coding interactive controls and inserting the interactive controls in an e-mail message.

Claims 6, 24, and 39 are rejected on the basis that Khan teaches a send button that somehow responds to the content of a pre-selected portion. It is not clear to applicants where Khan makes such a teaching. In any case claim 6 is dependent upon claim 1, claim 24 is dependent upon claim 19, and claim 39 depends from claim 37. These dependent claims should be allowed for at least the same reasons as discussed above for claims 1, 19, and 37.

Claims 40, 41, 44, and 45 are rejected on the same basis as claims 25, 26, 29, and 30. These claims should be allowed for the same reasons as discussed above for claims 25, 26, 29, and 30.

Claim 16, 17, 34, 35, 47 and 48 are rejected based on column 6, lines 12-26 of the Khan reference. Khan is only describing the linking of cells between a client and server. It is not clear how he proposes that the cells be linked. Further, Khan does not teach that the interactive control in applicants' invention enables a recipient to manipulate the content of the pre-selected portion. In other words, in applicants' claimed invention the operative program elements to manipulate the pre-selected portion are transmitting with the pre-selected portion. Claim 47 depends from claim 37 and should be allowed for the same reason that claim 37 is allowed as discussed above. In any case claim 16 and 17 depend from claim 1, claims 34 and 35 are dependent upon claim 19, and claims 47 and 48 depend from claim 37. These dependent claims should be allowed for at least the same reasons as discussed above for claims 1, 19, and 37.

In addition, these dependent claims should be allowed in their own right because Khan does not teach interactive control transmitted with the e-mail allows the recipient to manipulate the pre-selected portion.

Claims 3, 9-10, 21, and 27-28 have been rejected under 103(a) as being unpatentable over Gilbert in view of U.S. Patent No. 5,748,188 to Hu et al.

The Hu patent is cited as coding a portion of a document into HTML for e-mailing to a client. The examiner cites column 10, lines 48-65 of the Hu patent.

The Hu patent is directed to sending graphical data using the HTML language. The Hu patent does not fill any of the deficiencies of the Gilbert reference discussed above. Hu does not receive a pre-selected portion and in response to the send command, code that pre-selected portion into a form for transmission in an e-mail. At column 10, lines 48-65, the Hu reference is describing an "Infotrame" subsystem that allows a user to display and format text, tables and graphs and then attach them as an HTML file to an e-mail. Just as Gilbert was deficient in teaching receiving a portion of a document and responding to a send command to encode and send the document, Hu does not teach these operative elements. Claims 3, 9, and 10 should be allowed for the same reasons as discussed above for claim 1. Claims 21, 27, and 28 are dependent from claim 19 and should be allowed for the same reasons as discussed above for claim 19.

Claims 12 and 30 have been rejected under 103(a) as being unpatentable over Gilbert. Claims 12 and 30 depend from claims 1 and 19 respectively, and should be allowed for the same reasons as discussed above for claims 1 and 19.

Claim 15 and 33 have been rejected under 103(a) as being unpatentable over Gilbert in view of U.S. Patent No. 6,542,923 to Nguyen.

The Nguyen reference does not satisfy any of the deficiencies of the Gilbert reference. Claims 15 and 33 are dependent from claims 1 and 19 respectively, and should be allowed for the same reasons as claims 1 and 19.

Claims 38 and 42-43 have been rejected under 103(a) as being unpatentable over Gilbert in view of Khan et al. as applied to claim 37, and further in view of Hu. As claims 38, 42 and 43 depend from claim 37, and the Hu reference does not satisfy any of the deficiencies of Gilbert and Kahn regarding the combination of elements in claim 37, claims 38, 42 and 43 should be allowed for the same reasons as discussed above for claim 37.

Claim 46 has been rejected under 103 (a) as being unpatentable over Gilbert in view of Khan et al. as applied to claim 37, and further in view of Nguyen. As claim 46 depends from claim 37, and the Nguyen reference does not satisfy any of the deficiencies of Gilbert and Kahn regarding the combination of elements in claim 37, claim 46 should be allowed for the same reasons as discussed above for claim 37.


As all claims now in the application are in condition for allowance, Applicants request the application be allowed and pass to issuance as soon as possible.

It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

Respectfully submitted,

Merchant & Gould, P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
303.357.1633

Date: November 12, 2003



Homer L. Knearl, Reg. No. 21,197

